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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/773,812	02/06/2004	Andrew R. Ferlitsch	SLA1439	8259
50735	7590	11/13/2008	EXAMINER	
MADSON & AUSTIN 15 WEST SOUTH TEMPLE SUITE 900 SALT LAKE CITY, UT 84101			HAILU, TESHOME	
ART UNIT	PAPER NUMBER			
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/773,812	<b>Applicant(s)</b> FERLITSCH ET AL.
	<b>Examiner</b> TESHOME HAILU	<b>Art Unit</b> 2439

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If no period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 02 September 2008.
- 2a) This action is FINAL.                  2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1,3-7,9-11,13-16,18-20,22-26 and 28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1, 3-7, 9-11, 13-16, 18-20, 22-26 and 28 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)  
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
 3) Information Disclosure Statement(s) (PTO/SB/08)  
 Paper No(s)/Mail Date \_\_\_\_\_
- 4) Interview Summary (PTO-413)  
 Paper No(s)/Mail Date \_\_\_\_\_
- 5) Notice of Informal Patent Application  
 6) Other: \_\_\_\_\_

**DETAILED ACTION**

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on September 02, 2008 has been entered.
  
2. Claims 1, 3-7, 9-11, 13-16, 18-20, 22-26 and 28 have been amended.
3. Claims 2, 8, 12, 17, 21 and 27 have been canceled.
4. Claims 1, 3-7, 9-11, 13-16, 18-20, 22-26 and 28 are pending.

***Response to Arguments***

5. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Wu (US Pub. No. 2002/0042884) in view of Namba (US Pub. No. 2003/0140009) teaches the independent claims limitation, "Encrypting content of the imaging job and not encrypting non-content such that a downstream non-content dependent process will still properly process the imaging job;", as (page 2, paragraph 46, an encrypted form of the sensitive part is preferably sent to the recipient when the recipient is registered with the server, the server managing the decryption key; the sensitive part being decrypted when and as required). Also Namba disclosed, (page 10, paragraph 139, The message 70 (usage environment information notice) includes a header (non-content) which is not subject to encryption, a payload (content) which is subject to encryption and a trailer). Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention was made, to modify the teaching of Wu and include the method of not encrypting non-content

information using the teaching of Namba in order to separate the copyright related information (encrypted or payload) from the attached (header or basic) information and reduce the encryption process.

***Response to Amendment***

6. Applicant's amendment filed on September 02, 2008 with respect to the objections of claims 8, 17 and 22-28 have been fully considered in view of the cancellation and amendment to the claims and are persuasive. The objections to the claims have been withdrawn.
  
7. Applicant's amendments with respect to claims 1, 3-7, 9-11, 13-16, 18-20, 22-26 and 28 have been considered but are moot in view of the new ground(s) of rejection.

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:
  - (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.
  
9. Claims 1, 3-7, 9-11, 13-16, 18-20, 22-26 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wu (US Pub. No. 2002/0042884) in view of Namba (US Pub. No. 2003/0140009) and further in view of Lordemann (US Pub. No. 2002/0046350).

As per claim 1 Wu discloses:

A method for securing an imaging job, the method comprising: performing an access control function relating to a document; (page 4, paragraph 89, the communication server system consists of at least one server that provides the necessary facilities for secure and reliable document delivery. It acts as a trusted third party in authenticating the sender, and the recipient, the transaction is based on the

internal public key infrastructure protocol). According to the invention (paragraph 17), determination of user authorization (authentication) is performed by the access control function.

Generating an imaging job from the document; (abstract, line 1-3, a method for printing a document using network system).

Decrypting the encrypted content by a recipient; (page 6, paragraph 154, the recipient decrypts the key and hash using the password obtained separately to decrypt the data using the key).

Encoding into imaging output non-destructible information; (page 2, paragraph 42, adding an optical watermark during printing).

Erasing residual data that relates to the imaging job. (Page 8, paragraph 191, the sensitive part can be obtained from the hardware during printing and erased from memory immediately the printing process is completed).

Encrypting content of the imaging job and not encrypting non-content such that a downstream non-content dependent process will still properly process the imaging job; (page 2, paragraph 46, an encrypted form of the sensitive part is preferably sent to the recipient when the recipient is registered with the server, the server managing the decryption key; the sensitive part being decrypted when and as required).

Wu does not explicitly disclose about the method of not encrypting non-content information. However, on the same field of endeavor, Namba teaches this limitation as, (page 10, paragraph 139, The message 70 (usage environment information notice) includes a header (non-content) which is not subject to encryption, a payload (content) which is subject to encryption and a trailer).

Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention was made, to modify the teaching of Wu and include the method of not encrypting non-content information using the teaching of Namba in order to separate the copyright related information (encrypted or payload) form the attached (header or basic) information and reduce the encryption process.

Performing an auditing function relating to the document (page 5, paragraph 126, an audit trial to record the entire process), including extracting reduced content information from the document and storing the reduced content information in secured storage as at least part of an audit trail generated by

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the auditing function; (page 8, paragraph 189, the sensitive part is compressed and kept to reduce the download time).

Wu and Namba does not explicitly disclose about the method of comprising a reduced content in audit trail. However, on the same field of endeavor, Lordemann teaches this limitation as, (page 2, paragraph 13, it would be desirable to store information such as the request, authentication, authorization, serialization of the requested object, nonce of the requested object, security policy of the requested object, and a description of the protected object in the audit trail to provide comprehensive protection and demonstrate the integrity and irrefutability of the audit trail).

Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention was made, to modify the teaching of Wu and Namba to include the method comprising a reduced content in audit trail using the teaching of Lordemann in order to protect objects such as code, documents and images that are distributed over a network. (See page 1, paragraph 2 of Lordemann).

Claims 11 and 20 are rejected under the same reason set forth in rejection of claim 1:

As per claim 3 Wu in view of Namba and further in view of Lordemann discloses:

The method of claim 1, further comprising transmitting the imaging job from a client to the recipient, and wherein the transmitting is performed in between the encrypting and the decrypting. (Page 2, paragraph 46, an encrypted form of sensitive part is sent to recipient for printing and delete upon completion of the printing job to protect the data from attacker).

Claims 13 and 22 are rejected under the same reason set forth in rejection of claim 3:

As per claim 4 Wu in view of Namba and further in view of Lordemann discloses:

The method of claim 1, wherein the actions are performed in the order as listed. (Page 7, paragraph 168, the printing job is placed in the queue of the spool).

Claim 23 is rejected under the same reason set forth in rejection of claim 4:

As per claim 5 Wu in view of Namba and further in view of Lordemann discloses:

The method of claim 1, wherein the access control function determines if a user has authorization to perform a certain operation by using access control information. (Page 4, paragraph 89, the communication server system consists of at least one server that provides the necessary facilities for secure and reliable document delivery. It acts as a trusted third party in authenticating the sender, and the recipient, the transaction is based on the internal public key infrastructure protocol).

Claims 14 and 24 are rejected under the same reason set forth in rejection of claim 5:

As per claim 6 Wu in view of Namba and further in view of Lordemann discloses:

The method of claim 5, wherein the access control information comprises data that is selected from the group consisting of a login identification, a department code, client device identification, recipient device identification, imaging operation, meta-data, a serial number, a network address, a digital signature and biometric data. (Page 2, paragraph 26-34, the secure document delivery and printing control may be based on a trusted document structure like digital signature, optical watermark usage control and audit trail). Further Wu disclosed, (page 2, paragraph 44, the server may communicate with the printer to verify the printer serial number and internet protocol address).

Claims 15 and 25 are rejected under the same reason set forth in rejection of claim 6:

As per claim 7 Wu in view of Namba and further in view of Lordemann discloses:

The method of claim 1, wherein the access control function determines authorized content and causes the authorized content to be processed to create the imaging job. (Abstract, line 3-10, authenticate a document prior to being forwarded to the recipient for printing).

Claims 16 and 26 are rejected under the same reason set forth in rejection of claim 7:

As per claim 9 Wu in view of Namba and further in view of Lordemann discloses:

The method of claim 1, wherein the non-destructible information encoded into the imaging output comprises tracking information. (Page 11, paragraph 276, information about printed document is kept in audit trail inside the server for predetermined time).

Claims 18 and 28 are rejected under the same reason set forth in rejection of claim 9:

As per claim 10 Wu in view of Namba and further in view of Lordemann discloses:

The method of claim 9, wherein the tracking information comprises client tracking information and imaging device tracking information. (Page 11, paragraph 276, audit trail information is generated and signed by the program inside the hardware device with receiver's ID key after each copy printed, which provides non-repudiation for each printed copy). Where non-repudiation means a way of verifying content transferred from sender to recipient.

Claim 19 is rejected under the same reason set forth in rejection of claim 10:

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to TESHOME HAILU whose telephone number is (571)270-3159. The examiner can normally be reached on Mon-Fri 7:30a.m. to 5:00p.m. EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kambiz Zand can be reached on (571) 272-3811. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Teshome Hailu

November 6, 2008

/Kambiz Zand/  
Supervisory Patent Examiner, Art Unit 2434